

DETAILED ACTION

Petition to Revive

1. On 29 September 2008 Applicant filed a petition (“September 2008 Petition”) to revive the current application.
2. The USPTO Office of Petitions granted Applicant’s September 2008 Petition on 10 March 2010 (“March 2010 Decision”). Because the September 2008 Petition was granted, as noted in the March 2010 Decision, the abandonment of 19 September 2008 is withdrawn and prosecution will continue.

Acknowledgements

3. This action is responsive to the March 2010 Decision and Applicants' amendments received 28 .
4. This action has been assigned paper number 20100603 for reference purposes only.
5. Claims 1-39 are pending.
6. Claims 8, 15, 19, 20, and 35 are withdrawn herein.
7. Claims 1-7, 9-14, 16-18, 21-34, and 36-39 have been examined.

Restrictions

8. Applicant's election without traverse of Species A in the reply filed on 28 January 2008 is acknowledged.

9. Claims 8, 15, 19, 20, and 35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 28 January 2008.

Specification

10. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1), MPEP § 2181 and its discussion of C.F.R. § 1.75(d)(1), and MPEP § 608.01(o). Correction of the following is required:

- a. "incarcerative Transaction Code Identifiers" in at least claim 1;
- b. "means for rating content in accordance with regional and global standards" in at least claim 3;
- c. "means for including rating standards within TCI information" in at least claim 3;
- d. "generic incarcerated...TCI's" in at least claim 4;
- e. "means for rendering ICP's and II's" in at least claim 11;
- f. "means for associating, watermarking, bundling and embedding said TCI into said ICP" in at least claim 11;
- g. "means for associating, watermarking, bundling and embedding said {TCI} into said II" in at least claim 11;
- h. "means for establishing said ICP and II as unique...commerce" in at least claim 11;
- i. "means for making the TCI and {TCI} human and machine readable...properties" in at least claim 11;

- j. "means for inspecting all transmissions....{TCI's}" in at least claim 11;
- k. "means for placing the requirements for the lawful sale...{TCI's}" in at least claim 12;
- l. "means for promoting authorized peer-to-peer distribution...commerce" in at least claim 12;
- m. "means for electing...II's" in at least claim 13;
- n. "means for gating the downloading...II" in at least claim 13;
- o. "means for placing specific addresses...management" in at least claim 14;
- p. "step for transmitting ICP's and II's...devices" in at least claim 16;
- q. "step for associating, embedding, watermarking and bundling...restrictions" in at least claim 16;
- r. "step for creating TCI's and {TCI's}...properties" in at least claim 16;
- s. "step for inspecting all ICP's and II's...devices" in at least claim 16;
- t. "step for automatically triggering...II's" in at least claim 16;
- u. "step for presenting the legal requirements of transfer...ICP's/II's" in at least claim 16;
- v. "step for verifying that the legal requirements...have been met" in at least claim 16;
- w. "step for releasing and transmitting...user devices" in at least claim 16;
- x. "step for including, bundling, associating, watermarking, or embedding...II's" in at least claim 17;

- y. "step for including, bundling, associating, watermarking, or embedding, the said TCI/{TCI} with specific and regional specific addressing information" in at least claim 17;
- z. "step for said global digital communication...placing...transmissions" in at least claim 17;
 - aa. "step for...assessing...II's" in at least claim 17;
 - bb. "step for gating said transaction...met" in at least claim 18;
 - cc. "[m]eans for embedding, watermarking, associating and bundling...preferences" in at least claim 21;
 - dd. "step for generating a Transaction Code Identifier...commerce" in at least claim 23;
 - ee. "step for recognizing the said TCE/II...devices" in at least claim 23;
 - ff. "step for inspecting all digitized transmissions...devices" in at least claim 23;
 - gg. "step for gating said transmission(s)...devices" in at least claim 23;
 - hh. "step for validating that the legal requirements of transfer...have been met...devices" in at least claim 23;
 - ii. "step for transferring said transmission...validated" in at least claim 23;
 - jj. "step for associating, embedding, watermarking or bundling...{TCI's}" in at least claim 24;
 - kk. "step for recognizing...{TCI's}" in at least claim 24;
 - ll. "step for generating said TCI's/{TCI's}...ICP/II" in at least claim 24;

- mm. "step for providing ICP Property Management Protection... recipient(s)" in at least claim 24;
- nn. "step for recognizing the said (TCI), ({TCI})...devices" in at least claim 29;
- oo. "step for generating said generic TCI/{TCI}...II's" in at least claim 30;
- pp. "step for associating, embedding, or watermarking said generic ICP's/II's" in at least claim 30;
- qq. "step for making the said generic TCI's/{TCI}'s...users" in at least claim 30;
- rr. "step for making said generic TCI's/{TCI}'s...recipient(s)" in at least claim 30;
- ss. "step for generating Property Specific TCI's/{TCI}'s...II's" in at least claim 31;
- tt. "step for associating, watermarking, embedding, or bundling...II's" in at least claim 31;
- uu. "step for recognizing...addresses" in at least claim 31;
- vv. "step for gating the transmission...devices" in at least claim 32;
- ww. "step for presenting the requirements...II's" in at least claim 32;
- xx. "step for transferring said ICP's...end users" in at least claim 32;
- yy. "step for be embedding, prefacing, or associating...Routers" in at least claim 36;
- zz. "step for third party Internet Servicing agencies...Property" in at least claim 36;
- aaa. "step for said third party...preferentially routing...preferences" in at least claim 36;
- bbb. "step for generating a Transaction Code Identifier [TCI]...commerce" in at least claim 37;

- ccc. "step for generating incarcerative Transaction Code Identifiers ({TCI's}...ICP's" in at least claim 37;
- ddd. "step for recognizing...devices" in at least claim 37;
- eee. "step for said third party...preferentially routing... preferences" in at least claim 37;
- fff. "step for said third party...detecting...Property" in at least claim 38; and
- ggg. "step for determining geographical locations...devices" in at least claim 39.

Claim Rejections - 35 USC § 112 2nd Paragraph

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-7, 9-14, 16-18, 21-34, and 36-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 1 recites "[a]n Intellectual Property Archive (IPA), comprised of a tiered, peer-to-peer network, of distributed authentication, processing, storage and dissemination" which renders the claim indefinite. The structure of "a tiered, peer-to-peer network, of distributed authentication, processing, storage and dissemination" would not be understood by one of ordinary skill in the art.

14. In claim 1, the phrase “incarcerative Transaction Code Identifiers” is indefinite because—to one of ordinary skill in this art—the metes and bounds of the phrase can not be reasonably determined. First, the Examiner has carefully reviewed the original specification and can not locate, let alone ascertain, a lexicographic definition for this phrase. Second, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03. Based upon this review and the review of the original specification, it is the Examiner’s position that the phrase “incarcerative Transaction Code Identifiers” (as used in the context of these particular claim(s)) is not known to those of ordinary skill in this art. However, if Applicant(s) believe that the phrase *is* old and well known in the art, Applicant(s) should (in their next appropriately filed response) expressly state on the record that the phrase is old and well known in the art and provide appropriate evidence in support thereof (*e.g.* a U.S. patent). Upon receiving (1) Applicant(s)’ express statement that the phrase is old and well known in the art and (2) sufficient evidence in support thereof, the Examiner will withdraw this particular 35 U.S.C. §112 2nd paragraph rejection.

15. Claims 2, 4, 9-12, 14, 16-18, 21, 23-27, 29-31, and 37-39 also contain limitations directed to “incarcerative Transaction Code Identifiers,” “incarcerative TCI’s,” or “[TCI’s].” Claims 2, 4, 9-12, 14, 16-18, 21, 23-27, 29-31, and 37-39 are rejected under the same rationale as claim 1

16. Claim 9 recites “a physically dispersed...system of computers...and end user devices” which renders the claim indefinite.

17. The phrase “physically dispersed” is indefinite because—to one of ordinary skill in this art—the metes and bounds of the phrase can not be reasonably determined. First, the Examiner

has carefully reviewed the original specification and can not locate, let alone ascertain, a lexicographic definition for this phrase. Second, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03. Based upon this review and the review of the original specification, it is the Examiner's position that the phrase "physically dispersed" (as used in the context of these particular claim(s)) corresponds to a range or degree of physical separation not known to those of ordinary skill in this art.

18. For example, if all of the devices were in a single room, but not physically touching, would they be "physically dispersed?" Do they have to be in different rooms? Do they have to be in different buildings? Do they all have to be physically separated? Can some of them be in one place and some in another? Or do they all have to be in different locations?

19. Regarding claims 29-34:

hhh. These claims are indefinite because they are considered hybrid claims. See MPEP §2173.05(p) II. In particular, the claims are directed to neither a "process" or a "machine" but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.

iii. For example, claim 29 recites "[a] system," "Servers," and "Routers." In light of this evidence, one of ordinary skill in the art could reasonably interpret these recitations as express intent by Applicant(s) to claim a machine claim. Alternatively, claim 29 recites "for associating, embedding, watermarking or bundling...{TCI's},," "step for generating said TCI's/{TCI's}...ICP/II," and "step for providing ICP Property Management Protection... recipient(s)." One of ordinary skill in the art could also

reasonably interpret these recitations as express intent by Applicant(s) to claim a process claim. In light of this conflicting evidence, a person of ordinary skill in the art could reasonably interpret claim 1 to be drawn to either a product or process.

jjj. Therefore in accordance with §2173.05(p) II which states that a single claim must be drawn to either a product or process (but not both) and because a potential competitor of Applicant(s) would not know whether *possession alone* of the claimed structure constituted infringement, or alternatively, if infringement required the *execution* of the recited method steps, the claims are indefinite.

MEANS OR STEP PLUS FUNCTION

20. The words "means for" or "step for" are special when used in patent claims. See 35 U.S.C. 112 6th paragraph and MPEP § 2181. MPEP § 2181 sets forth a 3-prong analysis for determining if a limitation is to be presumed to invoke 35 U.S.C. § 112 6th paragraph. When the 3-prong analysis determines that a limitation does invoke 35 U.S.C. § 112 6th paragraph, the corresponding structure, material, or acts for the limitation must be clearly linked and associated with the limitation in the specification. See MPEP § 2181 III. (B)(2). The corresponding structure, material or acts found in the specification are used to interpret the scope of the limitation.

21. In the current claims, each of the above noted limitations for which antecedent basis could not be found in the specification, that also includes "means for" or "step for" has also been determined to invoke interpretation under 35 U.S.C. § 112 6th paragraph. These means or step plus function limitations are not clearly linked and associated with their corresponding

structures, materials, or acts. Therefore, claims 3, 11-14, 16-18, 21, 23, 24, 29-32, and 36-39 are rejected for being indefinite because the metes and bounds of the claims cannot be ascertained.

22. Claims 3, 14, 21, 22, 25-29, 31, 34, and 37-39 recite limitations such as “means wherein,” “means of,” “means whereby,” “step of,” “step wherein,” or “step whereupon” which do not meet prong A set forth in MPEP § 2181.

23. However, it is unclear whether these claim elements are means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph, because the Board and the courts have determined that “means for” or “step for” need not be present in a means or step plus function limitation. See MPEP § 2181 I, paragraph 4 for some examples. If Applicant wishes to have the claim limitations treated under 35 U.S.C. 112, sixth paragraph, Applicant is required to:

(a) Amend the claim to include the phrase “means for” or “step for” in accordance with these guidelines: the phrase “means for” or “step for” must be modified by functional language and the phrase must **not** be modified by sufficient structure, material, or acts for performing the claimed function; or

(b) Show that the claim limitation is written as a function to be performed and the claim does **not** recite sufficient structure, material, or acts for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph. For more information, see MPEP § 2181.

24. If Applicant does not wish to have the claim limitations treated under 35 U.S.C. 112, sixth paragraph, Applicant should avoid using the words “means” or “step” in a manner where they might be interpreted as being a means or step plus function limitation.

25. Because it is unclear if 35 U.S.C. § 112 6th paragraph is invoked by these limitations, claims 3, 14, 21, 22, 25-29, 31, 34, and 37-39 are rejected as being indefinite because one of ordinary skill cannot determine the metes and bounds of these claims.

26. Claims 1-7, 9-14, 16-18, 21-34, and 36-39 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

27. The claims are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The methods must clearly set forth the steps being performed. Note the format of the claims in the patent(s) cited.

28. The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied as much as practically possible.

Claim Rejections - 35 USC § 101

29. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

30. Claims 1 and 2 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

31. Statutory subject matter must fall into one of four categories: Process, Machine, Manufacture, or Composition of matter. See memorandum¹ by USPTO Acting Deputy Commissioner for Patent Examination Policy Andrew Hirshfeld Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101² (August 24, 2009) (“Hirshfeld 101 Memo”). Each of Machine, Manufacture, and Composition of matter require structure to be statutory (Page 3, II. A.). Processes must comprise method steps and satisfy the machine or transformation test (Page 4, II. B.).

32. Neither claim 1 nor claim 2 set forth any steps or structures that are statutory. Therefore, claims 1 and 2 are rejected as being non-statutory under 35 U.S.C. § 101.

Claim Rejections - 35 USC § 103

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. Claims 1-7, 9-14, 16-18, 21-34, and 36-39, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeager (US 2004/0088646) and Klug (US 2005/0004881).

¹ See MPEP §707.06 “Citation of Decisions, Orders Memorandums, and Notices” expressly authorizing the Examiner to cite to Commissioner’s Memorandums which have not yet been incorporated into the MPEP.

35. Due to the numerous issues set forth above it is impossible to properly construe the claims at this time. However, in the spirit of compact prosecution, the Examiner provides the following references and citations that show the limitations as understood by the Examiner.

36. As to claims 1-7, 9-14, 16-18, 21-34, and 36-39, Yeager teaches a peer to peer network with redundant computer devices (Figure 1B) which at multiple nodes performs content control of the content being transmitted across the network [0010] according to a header (Element 250, Figure 5). Additionally, the content is marked by means of setting a bit or watermarking to show that it is copyrighted [0205]. Yeager further teaches universal unique identifiers to identify any of: a peer, peer group, service, application, pipe, advertisement, endpoint, or content [0391]. Yeager does not expressly show the particular devices contained within the network. However, Klug shows a communications system with ISP's, routers, and other network nodes [0031]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Yeager to use the particular devices as taught by Klug because both inventions are directed toward the control and routing of content communications.

Conclusion

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

² Available at http://www.uspto.gov/patents/law/comments/2009-08-25_interim_101_instructions.pdf

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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